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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,187	10/02/2003	Robert N. Hunt	PO7947/MD-00-117-PU	8339

157 7590 04/30/2008
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EXAMINER	
MOSS, KERI A	
ART UNIT	PAPER NUMBER
1797	
MAIL DATE	DELIVERY MODE
04/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	**Application No.** 10/677,187	**Applicant(s)** HUNT ET AL.	
	Examiner KERI A. MOSS	**Art Unit** 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2007*.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's Response to Non-Final Rejection filed November 30, 2007 is hereby acknowledged. Claims 1-11 are pending.

Response to Amendment

2. The rejections of claims 1-11 under Kamke and Hunt in view of Kamke are maintained.

3. The obviousness-type double patenting rejection has been maintained.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims **1-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamke et al (Measurement of Resin and Wax Distribution of Wood Flakes, Forest Products Society, Vol. 46, No. 6 pgs 63-68). Kamke et al teaches a method for determining binder distribution on a sample comprising: contacting a sample with a transfer medium in a manner such that the binder present on the sample surface is transferred to the transfer medium, which is filter paper, (Introduction, citing Kuo et al.); exposing the transfer medium to ultraviolet radiation to make the binder fluoresce (Materials and Methods); imaging visible wave emissions of the fluorescing binder present on the transfer medium onto a camera (Materials and Methods); converting the image generated to an electronic signal and relaying the electronic signal to a means for

correlating distribution of binder to the electronic signal received (Image Processing and Analysis). The binder may be a polyisocyanate-based material, polymeric MDI, a polyisocyanate-based material having an oligomeric content of at least 20% or a polyisocyanate-based material having an oligomeric content of at least 25% (Materials and Methods). The means for correlating distribution of binder to the electronic signal received is a computer (Image Processing and Analysis) The camera used to image the visible wave emissions is also capable of converting the image to an electronic signal (Image Processing and Analysis). The transfer medium is exposed to long wave ultraviolet radiation (Introduction). A process for the production of wood strand board comprises applying a polyisocyanate to wood strands, monitoring the polyisocyanate/wood strand material in accordance with the method of Claim 1 until the polyisocyanate distribution is within a previously determined acceptable range, forming the polyisocyanate/wood strand material into the desired shape or form, and subjecting the polyisocyanate/wood strand material to curing conditions (Introduction).

Kamke et al. do not incorporate into their disclosed method the use of a transfer medium of Kuo et al. (Introduction, citing Kuo et al.); nor does Kamke et al teach away from using this method. Kuo used fluorescence microscopy and image analysis to measure individual resin spots on white filter paper specimens. Transferring the binder to a transfer medium such as filter paper results in easier handling and imaging, since the image is taken from a flat piece of paper rather than a piece of wood. The combination of Kuo's transfer medium to Kamke's means for correlating distribution of the binder would have yielded the predictable result of increasing the ease of handling and imaging of the binder. It would have been obvious to one of ordinary skill in the art to combine Kuo's method with a transfer medium with Kamke's means for correlating distribution of the binder to obtain the predictable result of easier handling and imaging of the binder.

Kamke et al. does not disclose the percentage of the binder that must be present in the filter paper transfer medium. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) teaches that optimization of a result-effective variable is ordinarily within the skill of one in the art. A result-effective variable is one that has well-known and expected results. The selection of the amount of binder transferred from the sample to the transfer medium is a result effective variable. Varying the amount of binder transferred from the sample has the well-known and expected result of improving the accuracy of the determination. Therefore, it would have been obvious to one of ordinary skill in the art to meet the transferred requirements of claimed at least 15-25% binder by modifying Kamke et al. and selecting the percentage binder transferred from the sample in order to ensure the accuracy of the determination of binder distribution in the sample.

6. Claims **1-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al. (USP 6,867,421) in view of Kamke et al, supra. Hunt et al teaches a method for determining binder distribution on a sample comprising: exposing a sample to ultraviolet radiation to make the binder fluoresce; imaging visible wave emissions of the fluorescing binder present on sample onto a camera; converting the image generated to an electronic signal and relaying the electronic signal to a means for correlating

distribution of binder to the electronic signal received (Claim 1). The binder may be a polyisocyanate-based material, polymeric MDI, a polyisocyanate-based material having an oligomeric content of at least 20% or a polyisocyanate-based material having an oligomeric content of at least 25% (Column 6 lines 16-27). The means for correlating distribution of binder to the electronic signal received is a computer (Image Processing and Analysis) The camera used to image the visible wave emissions is also capable of converting the image to an electronic signal (Column 5 lines 21-36). The sample is exposed to long wave ultraviolet radiation (Introduction). A process for the production of wood strand board comprises applying a polyisocyanate to wood strands, monitoring the polyisocyanate/wood strand material in accordance with the method of Claim 1 until the polyisocyanate distribution is within a previously determined acceptable range, forming the polyisocyanate/wood strand material into the desired shape or form, and subjecting the polyisocyanate/wood strand material to curing conditions (Introduction).

Hunt does not teach contacting the sample with a transfer medium. It is well known among those with ordinary skill in the art that a method of sampling the binder distribution is to transfer binder from a wood sample onto a transfer medium. Kemke teaches that this practice has been known since 1991 (Introduction, citing Kuo et al. reference). Transferring the binder to a transfer medium such as filter paper allows for easier handling and imaging, since the image is taken from a flat piece of paper rather than a piece of wood. Therefore, it would have been obvious for one of ordinary skill in the art to modify Hunt by transferring the binder from the sample wood to a filter paper in order to gain the advantages of easier handling and imaging.

Neither Hunt et al. nor Kemke et al discloses the percentage of the binder that must be present in the filter paper transfer medium. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) teaches that optimization of a result-effective variable is ordinarily within the skill of one in the art. A result-effective variable is one that has well-known and expected results. The selection of the amount of binder transferred from the sample to the transfer medium is a result effective variable. Varying the amount of binder transferred from the sample has the well-known and expected result of improving the accuracy of the determination. Therefore, it would have been obvious to one of ordinary skill in the art to meet the transferred requirements of claimed at least 15-25% binder by modifying Hunt et al. and Kamke et al. and selecting the percentage binder transferred from the sample in order to ensure the accuracy of the determination of binder distribution in the sample.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims **1, 4 and 9-10** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,867,421 in view of Kamke et al., supra. Claim 1 of the ‘421 patent does not claim contacting the sample with a transfer medium. It is well known among those with ordinary skill in the art that a method of sampling the binder distribution is to transfer binder from a wood sample onto a transfer medium. Kemke teaches that this practice has been known since 1991 (Introduction, citing Kuo et al. reference). Transferring the binder to a transfer medium such as filter paper allows for easier handling and imaging, since the image is taken from a flat piece of paper rather than a piece of wood. Therefore, it would have been obvious for one of ordinary skill in the art to modify claim 1 of the ‘421 patent by claiming transferring the binder from the sample wood to a filter paper in order to gain the advantages of easier handling and imaging.

Neither the ‘421 patent’s claim 1 nor Kemke et al claims the percentage of the binder that must be present in the filter paper transfer medium. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) teaches that optimization of a result-effective variable is ordinarily within the skill of one in the art. A result-effective variable is one that has well-known and expected results. The selection of the amount of binder transferred from the sample to the transfer medium is a result effective variable. Varying the amount of binder transferred from the sample has the well-known and expected result of improving the accuracy of the determination. Therefore, it would have been obvious to one of ordinary skill in the art to meet the transferred requirements of claimed at least 15-25% binder by modifying claim 1 of the ‘421 patent and Kamke et al. and claiming the percentage binder transferred from the sample in order to ensure the accuracy of the determination of binder distribution in the sample.

Response to Arguments

9. Applicant's arguments filed November 30, 2008 have been fully considered but they are not persuasive.

10. Applicant argues that Kamke does not teach or suggest the disclosed method could be practiced without a microscope. However, applicant’s claims do not specify that a microscope is not used. Since applicant’s preamble uses the "comprising” language, prior art can still read on applicant's claims even if the prior art contains more limitations than applicant's claims. Here, Kamke still reads on applicants’ claims since they do not specify that a microscope is not used. Thus, the rejection is maintained.

11. Applicant argues that Kamke does not teach or suggest that the disclosed method could be successfully conducted by analysis of a binder-containing transfer medium. There is no reason to believe that the disclosed method could not be successfully conducted since both Kuo et al. and Kamke et al. use fluorescence imaging to measure resin spots.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KERI A. MOSS whose telephone number is (571)272-8267. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAM 4/27/08

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797